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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,520	12/03/2003	Robert Petit	0580-1006	5020
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YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER RUNNING, RACHEL A	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 06/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,520

Applicant(s)

PETIT, ROBERT

Examiner

Rachel A. Running

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6, 10 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-9, 11-16 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17 and 19, drawn to the brush, classified in class 15, subclass 159.1.
 - II. Claims 20-25, drawn to the brush and case, classified in class 132, subclass 313.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination can be used with a powder puff instead of a brush. The subcombination has separate utility such as being used as a brush that can dust a surface.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or

includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. If Group I is elected, then Applicant is further required to elect between the claims directed to the following patentably distinct species:

Species I, drawn to Figures 1a, 2a-2c.

Species II, drawn to Figure 1b.

Species III, drawn to Figures 3a-3c.

Species IV, drawn to Figure 4a.

Species V, drawn to Figures 5a-5c.

Species VI, drawn to Figure 6.

Species VII, drawn to Figure 7a.

Species VIII, drawn to Figure 7b.

4. The species are independent or distinct because the sheaf is located at different inclinations.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. Currently, claims 1, 2, 5, 14-17, and 19 are generic.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Applicant's election without traverse of Group I, and Species V, in the reply filed on March 19, 2007 is acknowledged.

6. Claims 5, 6, 10, and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, and claims 18 and 20-25 are canceled as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 19, 2007.

Specification

7. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Drawings

8. The drawings are objected to because dimension lines should not be used, Figures cannot be connected to another (Figures 2a, 2b, 2c, 2d, 3a, 3b, 3c, 5a, 5b, 8b, 8c, and 8d), and the Figures extraneous material, e.g. wording. See MPEP 37 CFR 1.84. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

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reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-4, 7-9, 11-16, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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11. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Some examples include: a broad range or limitation followed by linking terms (e.g., preferably, maybe, for instance, especially, typically, possibly) and a narrow range or limitation within the broad range or limitation which is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Others examples include dimensions such as distances e or e' wherein e and e' are not specifically defined. These are just some of the innumerable errors encountered. Applicant should carefully reread the claims and correct all errors therein.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-4, 7-9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathans (US 2,022,896).

Nathans discloses a rigid mount (28) having plural cavities (22) separated from each other (see Figure 5). Two tufts (18) are configured to apply a product onto a support. Each tuft includes a foot and a sheaf of flexible material (see Figures 5 and 6). Each sheaf is anchored in one of the cavities (22) and emerges from a different portion

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of the mount (28) along a different surface (see Figures 1 and 5; column 2, lines 25-30). Each sheaf defines a lateral envelope limited by the application surface (see Figure 3). The application surfaces are positioned to simultaneously allow at least two different applications of cosmetic onto the support with each application surface being free of overlap with any other application surface (see Figures 1 and 5). The different surfaces are non-planar with respect to each other (see Figure 5). The different surfaces are longitudinally rectangular, and the two sheaves are in the form of flexible curtains (see Figure 1). Each surface is free of contact with any adjacent surface and the surfaces are non-contiguous and are spaced apart by a distance (see Figure 5; column 2, lines 50-55). The different tufts are geometrically symmetrical relative to a plane of symmetry (see Figure 5).

Nathans does not disclose the mount having a larger dimension less than 50 mm, and a thickness less than 30% of the larger dimension (claim 1); the mount having a thickness less than 10 mm, each sheaf having a length from 50% to 150% of the larger dimension as taken between the mount and the application surface (claim 2); the different surfaces having a length from 5 to 20 mm and a width from 1 to 5 mm with a ratio of the length over the width being from 2 to 10 (claim 4); the sheaves having a maximum angle of aperture $\alpha > 0$, and a minimum angle of aperture $\alpha' > 0$ with $\alpha' < \alpha$ (claims 8 and 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the mount be of a larger dimension less than 50 mm, and have a thickness less than 30% of the larger dimension, since it has been held that where the general conditions of a claim are disclosed in the prior art,

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discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the mount be a thickness less than 10 mm, and have each sheaf be a length from 50% to 150% of the larger dimension as taken between the mount and the application surface, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the different surfaces be a length from 5 to 20 mm and a width from 1 to 5 mm with a ratio of the length over the width being from 2 to 10, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the sheaves be a maximum angle of aperture $\alpha > 0$, and a minimum angle of aperture $\alpha' > 0$ with $\alpha' < \alpha$, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

14. Claims 1-4, 7-9, 11-16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (US 2003/0178043).

Gueret discloses a rigid mount (13) having plural cavities (20) separated from each other (see Figures 2 and 17). At least two tufts (15) are configured to apply a product onto a support. Each tuft includes a foot and a sheaf of flexible material (see Figures 2-4; paragraph 0031). Each sheaf is anchored in one of the cavities (20) and emerges from a different portion of the mount (13) along a different surface (see Figures 2 and 17; paragraph 0094). Each sheaf defines a lateral envelope limited by the application surface (see Figure 2). The application surfaces are positioned to simultaneously allow at least two different applications of cosmetic onto the support with each application surface being free of overlap with any other application surface (see Figures 2-4). The different surfaces are non-planar with respect to each other (see Figures 2-4). The different surfaces are longitudinally rectangular and the two sheaves are in the form of flexible curtains (see Figure 2; paragraph 0038). Each surface is free of contact with any adjacent surface and the surfaces are non-contiguous and are spaced apart by a distance (see Figures 2-4). The different tufts are geometrically symmetrical relative to a plane of symmetry (see Figure 2). Each surface is in different planes and are perpendicular to a medium plane and forms an angle between them to conform to the users face (see Figures 15 and 16). The tufts are tufts of hair of the same texture or of different texture or nature (paragraph 0094). The tufts are formed by the same fibrous material and are anchored by bonding (paragraphs 00094, 0107).

Gueret does not disclose the mount having a larger dimension less than 50 mm, and a thickness less than 30% of the larger dimension (claim1); the mount having a thickness less than 10 mm, each sheaf having a length from 50% to 150% of the larger

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dimension as taken between the mount and the application surface (claim 2); the different surfaces having a length from 5 to 20 mm and a width from 1 to 5 mm with a ratio of the length over the width being from 2 to 10 (claim 4); the sheaves having a maximum angle of aperture $\alpha > 0$, and a minimum angle of aperture $\alpha' > 0$ with $\alpha' < \alpha$ (claims 8 and 9); the planes form an angle β equal to $150^\circ \pm 25^\circ$ (claim 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the mount be of a larger dimension less than 50 mm, and have a thickness less than 30% of the larger dimension, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the mount be a thickness less than 10 mm, and have each sheaf be a length from 50% to 150% of the larger dimension as taken between the mount and the application surface, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the different surfaces be a length from 5 to 20 mm and a width from 1 to 5 mm with a ratio of the length over the width being from 2 to 10, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at

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the time the invention was made to have the sheaves be a maximum angle of aperture $\alpha > 0$, and a minimum angle of aperture $\alpha' > 0$ with $\alpha' < \alpha$, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the planes form an angle β equal to $150^\circ \pm 25^\circ$, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

15. Applicant's arguments filed March 19, 2007 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel A. Running whose telephone number is (571) 272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


ROBYN DOAN
PRIMARY EXAMINER

Rachel A. Running
